



16 FEB 2000

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

United States Receiving Office  
United States International Searching Authority  
United States International Preliminary Examining Authority  
United States Designated Office  
United States Elected Office

Address: Assistant Commissioner for Patents  
Box PCT  
Washington, D.C. 20231

Michael R. Davis  
WENDEROTH, LIND & PONACK, L.L.P.  
2033 K. St. N.W. Suite 800  
Washington, D.C. 20006

In re Application of	:	
Yasuo FUKAGAWA et al.	:	DECISION GRANTING
Serial No.: 09/284,578	:	
PCT No.: PCT/JP97/03710	:	RENEWED PETITION
Int. Filing Date: 15 October 1997	:	
Priority Date: 15 October 1996	:	UNDER 37 C.F.R. § 1.47(a)
For: BIOLOGICALLY ACTIVE	:	
POLYMER PRODUCTS	:	

This is a decision on the renewed "PETITION UNDER 37 C.F.R. §1.47(a)" filed 08 October 1999, requesting that the above-captioned United States national stage application be accorded status under 37 C.F.R. § 1.47(a) without the signature of joint inventor Yasuo FUKAGAWA, who refuses to execute the application.

BACKGROUND

On 15 October 1997, applicants filed international application PCT/JP97/03710, which claimed priority of an earlier Japanese application filed 15 October 1996. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 23 April 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 03 April 1998, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 15 April 1999.

On 15 April 1999, applicants filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter were, inter alia: (1) the requisite basic national fee as required by 35 U.S.C. § 371(c)(1) and the English translation of the international application as required by 35 U.S.C. § 371(C)(2).

On 11 May 1999, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. § 371 (form PCT/DO/EO/905) indicating that an oath or declaration was required.

On 08 October 1999, in response to the Notice, the applicant provided (1) a petition for extension of time under 37 C.F.R. § 1.17(a)(4) and the required fee; (2) a petition under 37 C.F.R. § 1.47(a) and the required fee; (3) a declaration signed by inventor Akiko MIYA on his behalf and on behalf of the non-signing inventor Yasuo FUKAGAWA; and (4) a declaration signed by Hiromi Takayasu, who is the manager of the Patent Department of Ebara Corporation, the intended Assignee of the present application. The Declaration of facts includes correspondence between the non-signing inventor and Mr. Takayasu.

### DISCUSSION

A petition under 37 C.F.R. § 1.47(a) must be accompanied by: (1) the requisite \$130 petition fee required by 37 C.F.R. § 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration executed by each signing inventor on their behalf and on behalf of the non-signing joint inventor(s).

The evidence submitted in this petition by the applicant is sufficient to establish that joint inventor Mr. Yasuo FUKAGAWA has been presented a copy of the application papers and that he has placed "conditions" upon which he will sign the declaration. The "conditions," in effect, set forth evidence that he refuses to sign Declaration. Accordingly, the applicant has provided sufficient *prima facie* evidence that the missing joint inventor, Mr. Yasuo FUKAGAWA, refuses to execute the declaration. As such, the requirements of items (1) through (4) above have been satisfied. Accordingly, it is appropriate to accord the United States national stage application status under 37 C.F.R. § 1.47(a).

### DECISION

For the reasons discussed above, applicants' petition requesting that the United States national stage application be accorded status under 37 C.F.R. §1.47(a) is GRANTED.

The requisite **\$130** surcharge fee for a proper declaration later than the appropriate 30 months from the priority date (37 C.F.R. §1.492(e)), has been charged to Deposit Account No. 23-0975 pursuant to the authorization set forth in the petition.

Application Processing Division and the DO/EO/US are authorized to accept the application as a 37 C.F.R. §1.47(a) application to mail a Filing Receipt and a Notice of Acceptance of Application under 37 C.F.R. 371 (PCT/DO/EO/903). The application will be given an international filing date of 15 October 1997 under 35 U.S.C. §363, and a date of 08 October 1999 under 35 U.S.C. §371 and §102(e).

As provided in 37 C.F.R. § 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known addresses of record, and notice of the filing of the application will be published in the Official Gazette.



Lissi Mejica  
PCT Legal Examiner  
Telephone: (703) 305-2260  
Facsimile: (703) 308-6459



Conferee: Leonard E. Smith  
PCT Legal Examiner  
PCT Legal Office